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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/698,436 | 11/03/2003 | Bryan Martel | 442602000110 | 9425 |

7590 06/17/2005

Raj S. Dave
Morrison & Foerster LLP
Suite 300
1650 Tysons Boulevard
McLean, VA 22102

EXAMINER

COONEY, JOHN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1711

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,436

Applicant(s)

MARTEL ET AL.

Examiner

John m. Cooney

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED-STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-56 and 92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 41-56 and 92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's arguments filed 5/20/05 have been fully considered but they are not persuasive.

All previous rejections are withdrawn in light of applicants' cancellation of the rejected claims.

In light of new considerations, the finality of the previous Office action is withdrawn, and the following new rejections are set forth herein:

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41-56 and 92 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Chesler (4,451,583).

Chesler discloses comminuted flexible polyurethane foams, which may be based on and continue to contain methylene chloride, having particle sizes of less than 2 millimeters (see the entire document). When the prior art discloses a product which

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reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that burden is placed upon applicant to provide clear and convincing factual evidence that the respective products do in fact differ in kind – In re Brown, 59 CCPA 1063, 173 USPQ 685 (1972); In re Fessman, 180 USPQ 324 (CCPA) – and to come forward with evidence establishing unobvious differences between the claimed product and the prior art product. In re Marosi 218 USPQ 290.

Claims 41-56 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wagner et al.(5,669,559).

Wagner et al. discloses pulverized polyurethane foams which are seen to read on the products as claimed (see the examples, as well as, the entire document). When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that burden is placed upon applicant to provide clear and convincing factual evidence that the respective products do in fact differ in kind – In re Brown, 59 CCPA 1063, 173 USPQ 685 (1972); In re Fessman, 180 USPQ 324 (CCPA) – and to come forward with evidence establishing unobvious differences between the claimed product and the prior art product. In re Marosi 218 USPQ 290.

Additionally, the particle size values of applicants' claims are seen to be inherent resultant features of Wagner et al. attributable to the pulverizing operations employed.

Claims 41-56 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Proska et al.(5,451,376).

Proska et al. discloses comminuted polyurethane foams which are seen to read on the products as claimed (see the entire document). When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that burden is placed upon applicant to provide clear and convincing factual evidence that the respective products do in fact differ in kind – In re Brown, 59 CCPA 1063, 173 USPQ 685 (1972); In re Fessman, 180 USPQ 324 (CCPA) – and to come forward with evidence establishing unobvious differences between the claimed product and the prior art product. In re Marosi 218 USPQ 290. Additionally, the particle size values of applicants' claims are seen to be inherent resultant features of Proska et al. attributable to the comminuting operations employed.

Claims 41-56 and 92 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ascough et al.(4,976,862).

Ascough et al. discloses pulverized, crushed, and/or cut polyurethane foams containing solvent and blowing agent which are seen to read on the products as claimed (see the entire document). When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that burden is placed upon applicant to provide clear and convincing factual evidence that the respective products do in fact differ in kind – *In re Brown*, 59 CCPA 1063, 173 USPQ 685 (1972); *In re Fessman*, 180 USPQ 324 (CCPA) – and to come forward with evidence establishing unobvious differences between the claimed product and the prior art product. *In re Marosi* 218 USPQ 290. Additionally, the particle size values of applicants' claims are seen to be inherent resultant features of Ascough et al. attributable to the pulverizing, grinding, and/or cutting operations employed.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 41-56 and 92 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6,670,404. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of 6,670,404 disclose methods of preparing comminuted polymers, and differences in structure and make-up are variations of degree of processing which would have been obvious to one having ordinary skill in the art.

Claims 41-56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10/357,517. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose methods of preparing comminuted polymers, and differences in structure and make-up are variations of degree of processing which would have been obvious to one having ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

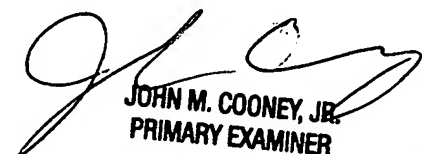
Claims 41-56 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-43 of copending Application No. 10/649,593. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose methods of preparing comminuted polymers, and differences in structure and make-up are variations of degree of processing which would have been obvious to one having ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
PRIMARY EXAMINER
GROUP 1700